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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,104	03/19/2007	Valerie Arranz	021305-00294	6158

4372 7590 10/13/2011
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EXAMINER

DEVI, SARVAMANGALA J N

ART UNIT	PAPER NUMBER
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1645

NOTIFICATION DATE	DELIVERY MODE
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10/13/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary	Application No.	Applicant(s)	
	10/568,104	ARRANZ, VALERIE	
	Examiner	Art Unit	
	S. DEVI, Ph.D	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-14 is/are pending in the application.
- 5a) Of the above claim(s) 1-9, 12 and 13 is/are withdrawn from consideration.
- 6) ☒ Claim(s) 14 is/are allowed.
- 7) ☒ Claim(s) 10 and 11 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Request for Continued Examination

1) A request for continued examination under 37 C.F.R 1.114, including the fee set forth in 37 C.F.R 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R 1.114, and the fee set forth in 37 C.F.R 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R 1.114. Applicant's submission filed on 06/08/11 has been entered.

Applicant's Amendment

2) Acknowledgment is made of Applicant's amendment filed 05/09/11 in response to the final Office Action mailed 10/20/10.

Status of Claims

3) Claims 10 and 11 have been amended via the amendment filed 05/09/11.
Claims 1-14 are pending.
Claims 10, 11 and 14 are under examination.

Prior Citation of Title 35 Sections

4) The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Prior Citation of References

5) The references cited or used as prior art in support of one or more rejections in the instant Office Action and not included on an attached form PTO-892 or form PTO-1449 have been previously cited and made of record.

Rejection(s) Maintained

6) The provisional rejection of claims 10 and 11 made in paragraph 10 of the Office Action mailed 10/20/10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of the co-pending application 12/278,912, is maintained for the reasons set forth therein. Applicant states that they would revisit this issue upon indication of allowance of claims 10 and 11.

Rejection(s) Withdrawn

7) The rejection of 10 and 11 made in paragraph 12 of the Office Action mailed 10/20/10 under 35 U.S.C. § 102(e)(1) as being anticipated by Avrameas *et al.* (US 2003/0199677 A1, of record) ('677), is withdrawn in light of Applicant's amendment to the claims. A new rejection is set forth below to address the claims as amended.

Rejection(s) under 35 U.S.C. § 102

8) The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language.

9) Claims 10 and 11 are rejected under 35 U.S.C. § 102(e)(1) as being anticipated by Avrameas *et al.* (US 2003/0199677 A1, of record) ('677).

Avrameas *et al.* ('677) taught a composition comprising the cell-penetrating peptides having the amino acid sequence of SEQ ID NO: 21, wherein the peptides have the advantageous capacity to allow transport of active substances through biological membranes and barriers. The peptides are coupled to an active substance. The peptide of SEQ ID NO: 21 is combined covalently or non-covalently to one substance of interest or some substances of interest such as an antibody, lysozyme, antibacterial cationic peptide, or an antibiotic (i.e., antibacterial compound) for internalization in to cells *in vivo* or *in vitro* and for treating or preventing a disease. A sequence search performed at the Office indicates that the prior art peptide of SEQ ID NO: 21 has a sequence that is 100% identical in structure to the instantly recited SEQ ID NO: 3. For example, the peptide coupled to lysozyme inhibited the growth of the Gram negative bacteria, *E. coli*, and therefore the composition is for the control of the Gram negative *E. coli*. See the sequence alignment below; and paragraphs [0085], [0068], [0069], [0078], [0079], [0085], [0151], [0242], [0243], [0495], [0498], [0501] to [0504]; Example 28; and claims 59-61.

US-10-231-889-21

Sequence 21, Application US/10231889

Publication No. US20030199677A1

GENERAL INFORMATION:

APPLICANT: Avrameas, Eustrate

APPLICANT: Ternynck, Therese

TITLE OF INVENTION: Amino Acid Sequences Facilitating Penetration Of A Substance Of Interest

TITLE OF INVENTION: Into Cells And/Or Nuclei

FILE REFERENCE: 20440-001

CURRENT APPLICATION NUMBER: US/10/231,889

CURRENT FILING DATE: 2002-08-29

PRIOR APPLICATION NUMBER: PCT/FR00/02621

PRIOR FILING DATE: 2001-03-01

PRIOR APPLICATION NUMBER: FR00/02621

PRIOR FILING DATE: 2000-03-01

NUMBER OF SEQ ID NOS: 51

SOFTWARE: PatentIn Ver. 2.1

SEQ ID NO 21

Application/Control No. 10/568,104
Art Unit: 1645
September, 2011

LENGTH: 17
TYPE: PRT
ORGANISM: Homo sapiens
US-10-231-889-21

Query Match 100.0%; Score 89; DB 4; Length 17; Best Local Similarity 100.0%;
Matches 17; Conservative 0; Mismatches 0; Indels 0; Gaps 0.

Qy	1	GRPRESGKKRKRRLKP	17
Db	1	GRPRESGKKRKRRLKP	17

At sections [0105] and [0106], Avrameas *et al.* taught that the peptide of their invention is directly coupled to the substance of interest via the preferred covalent coupling. Thus, direct covalent linking of the peptide of SEQ ID NO: 21 with an antibody, lysozyme, antibacterial cationic peptide, or an antibiotic (i.e., antibacterial compound) is not excluded from, but is expressly included within the scope of Avrameas's disclosure. In other words, Avrameas's disclosure is not limited to the one wherein SEQ ID NO: 21 is covalently coupled to an antibody, lysozyme, antibacterial cationic peptide, or an antibiotic (i.e., antibacterial compound) via a spacer arm, but also includes another embodiment wherein the SEQ ID NO: 21 is covalently coupled to an antibody, lysozyme, antibacterial cationic peptide, or an antibiotic (i.e., antibacterial compound) directly.

Furthermore, the preamble limitation 'for the control of Gram negative bacteria' represents the intended use of the claimed composition and has no patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and wherein the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 10 and 11 are anticipated by Avrameas *et al.* ('677).

Remarks

10) Claims 10 and 11 stand rejected. Claim 14 is allowable.

Correspondence

11) Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Central Fax number, (571) 273-8300, which receives transmissions 24 hours a day and 7 days a week.

12) Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.Mov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

13) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

Application/Control No. 10/568,104
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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor Gary Nickol, can be reached on (571) 272-0835.

/S. Devi/
Primary Examiner
AU 1645

September, 2011